

**REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-2 and 4-15 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, the amendments to claims 1, 4, 6 and 9 are supported by the Specification at, for example, page 12, line 15 to page 13, line 14. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

**Issues Under 35 U.S.C. 103(a)**

**Momoda '038**

Claims 1, 4-7, 9, 10 and 15 stand rejected under 35 U.S.C. 103(a) as obvious over EP 1,130,038 (hereinafter Momoda '038). Applicants respectfully traverse.

The Examiner asserts that Momoda '038 discloses a curable composition comprising (A) a polymerizable monomer, (B) a polyfunctional monomer, (C) a difunctional polymerizable monomer and (D) a photochromic compound. The Examiner further asserts that "the cured product of these compositions would have tensile strengths close enough to said strength that it would have been obvious for one of ordinary skill in the art to optimize the ratio of monomers to achieve a product with higher tensile strength."

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he

examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ 2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Momodá ‘038 discloses a curable composition which provides a photochromic cured product exhibiting excellent photochromic properties as well as excellent matrix characteristics, such as high hardness and a high heat resistance (see [0013]). All of the photochromic products in the Examples of Momodá ‘038 have a high L-scale Rockwell hardness (72 to 100) (see Tables 4, 5 and 6). As shown in the Declarations Under 37 C.F.R. 1.132 filed on February 20, 2009 and May 15, 2009, the photochromic cured products of Momodá ‘038 exhibit a low tensile strength (less than 20 kgf). As such, Momodá ‘038 merely discloses cured products having high hardness and low tensile strengths. Therefore, one skilled in the art would expect any cured product produced by the method of Momodá ‘038 to exhibit a high hardness and low tensile strength.

Thus, Applicants respectfully submit that one skilled in the art would not have been motivated to modify the teachings of Momodá ‘038 as proposed by the Examiner, in order to

arrive at cured products specifically having tensile strengths above 20 kgf, which would be contrary to the teachings of Momoda '038.

In view of the above, reconsideration and withdrawal of this rejection are respectfully requested.

### **Momoda '038 in view of secondary references**

Claims 2, 8, 11 and 13 stand rejected under 35 U.S.C. 103(a) as obvious over Momoda '038 in view of Imura et al. (U.S. 5,556,931) (hereinafter Imura '931). Additionally, claims 12 and 14 stand rejected as obvious over Momoda '038 in view of Geffcken et al. (U.S. 3,713,869) (hereinafter Geffcken '869). Applicants respectfully traverse.

The Examiner acknowledges that Momoda '038 is silent with regard to higher (m+n) values in the bifunctional polymerizable monomer (II). The Examiner further acknowledges that Momoda '038 is silent with regard to the use of a buffer layer interposed between the substrate and the hard coating layer. The Examiner relies on the teachings of Imura '931 and Geffcken '869 to overcome these deficiencies.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. As noted above, Momoda '038 fails to teach or suggest a photochromic lens substrate comprising a cured product of a polymerization curable composition, wherein the cured product has a tensile strength of 20kgf or more. The secondary references cited by the Examiner fail to cure this deficiency.

Imura '931 is directed to a polymerizable composition comprising at least two di(meth)acrylate compounds of general formula (I), suitable as a transparent resin. Geffcken '869

discloses a method of applying hard inorganic layers to plastics. However, both Imura '931 and Geffcken '869 fail to teach or suggest any components which could be used to provide a cured product having a tensile strength of 20 kgf or more. The disclosure of soft and hard monomers in Imura '931 does not provide any guidance for a person skilled in the art to arrive at the present invention. Thus, both references fail to teach or suggest a polymerizable curable composition or photochromic lens substrate as presently claimed.

Evidently, the cited references, alone or in combination, fail to teach or suggest every limitation of the instant invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Issues under 35 U.S.C. 112, 1<sup>st</sup> paragraph**

Claims 1-15 stand rejected under 35 U.S.C. 112, 1<sup>st</sup> paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse.

The Examiner asserts that the Specification, "while being enabling for specific types of other polymerizable monomers...does not reasonably provide enablement for *any* type of polymerizable monomer."

Applicants submit that the claims have been amended to correct the issues identified by the Examiner. Accordingly, this rejection is moot.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Reg. No. 61,158 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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